



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,706	04/12/2007	Yasumasa Mitani	20078.1USWO	4017

52835 7590 01/30/2012
HAMRE, SCHUMANN, MUELLER & LARSON, P.C.
P.O. BOX 2902
MINNEAPOLIS, MN 55402-0902

EXAMINER

MUMMERT, STEPHANIE KANE

ART UNIT	PAPER NUMBER
----------	--------------

1637

MAIL DATE	DELIVERY MODE
-----------	---------------

01/30/2012

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Applicant-Initiated Interview Summary

Application No.

10/583,706

Applicant(s)

MITANI ET AL.

Examiner

STEPHANIE K. MUMMERT

Art Unit

1637

All participants (applicant, applicant's representative, PTO personnel):

(1) Stephanie K Mummert.(3) Yuhgo Maruta.(2) Douglas Mueller.(4) Koichiro Tsujimaru.Date of Interview: 24 January 2012.Type: ☐ Telephonic ☐ Video Conference
☒ Personal [copy given to: ☐ applicant ☐ applicant's representative]Exhibit shown or demonstration conducted: ☒ Yes ☐ No.If Yes, brief description: see attached slides from power point presentation discussed.Issues Discussed ☐101 ☐112 ☐102 ☒103 ☒Others

(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: 1.Identification of prior art discussed: Rabbani and David.**Substance of Interview**

(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

See Continuation Sheet.

Applicant recodation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview

Examiner recodation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recodation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recodation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

☐ Attachment/STEPHANIE K MUMMERT/
Primary Examiner, Art Unit 1637

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Yumi Nakayama was also present for the interview. Applicant wanted to discuss the outstanding rejection before filing a response. In particular, Applicant wanted to establish the specific differences between the instant invention and the rejections of record. As noted in the power point presentation attached, the claims are drawn to a primer set comprising a turnback primer which hybridizes to the sense strand and a foldback primer that hybridizes to the antisense strand. Applicant emphasized that the primers in combination are useful for isothermal amplification and provide improved specificity.

Next, Applicant looked to Rabbani and noted that the obviousness rejection points to Figure 4, step 1 and refers to the hairpin to the 5' side of the figure as a "folded hairpin sequence" as a basis for the obviousness rejection. Applicant points to the presentation and the specification to establish that the combination of references is not suitable. Applicant emphasized that the B' sequence of the folded sequence in Figure 4 distinguishes over the foldback primer of the claims. Applicant also argued that paragraph 43 of Rabbani which notes that the primers "can be the same, or they can be different" refers to a different experiment or set of primer structures than those depicted in Figure 4.

Applicant finally referred to the Japanese opposition proceeding and noted that experiments were carried out as a part of the process and it was found that the turnback primer of Rabbani was combined with a PCR primer and amplification was not effective or efficient. Applicant argued that a "bad primer" controls the speed or efficiency of the amplification reaction.

Also, it was noted that the David reference does not provide much evidence or reduction to practice and primarily presents theoretical subject matter. Applicant also clarified the role of Demandee and Defendant as noted in the recent IDS documents.

Applicant will be pointing out the evidence noted above from the opposition process in Japan and presenting the data in a formal declaration in a forthcoming response. It was noted that a response will be coming within the next few weeks.